

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 020375-038600US	
I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office on <u>February 1, 2007</u> . TOWNSEND and TOWNSEND and CREW LLP By: <u>/Janet L. Newmaker/</u> Janet L. Newmaker		Application Number 10/673,061	Filed September 26, 2003
		First Named Inventor Jennifer Chamblee	
		Art Unit 3653	Examiner Mark Hageman
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,358</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____		<u>/Irvin E. Branch/</u> _____ Signature <u>Irvin E. Branch</u> _____ Typed or printed name <u>303-571-4000</u> _____ Telephone number <u>February 1, 2007</u> _____ Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> form is submitted.			

TOWNSEND and TOWNSEND and CREW LLP

By: /Janet L. Newmaker/
Janet L. Newmaker

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Jennifer Chamblee et al.

Application No.: 10/673,061

Filed: September 26, 2003

For: Mail Processing System And
Method

Customer No.: 20350

Confirmation No.: 1241

Examiner: Mark Hageman

Art Unit: 3653

PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection for the above-identified application. A response after final was filed on December 28, 2006. No amendments to the claims are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

REMARKS/ARGUMENTS

Claims 1-8 and 13-20 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,801,833 to Pintsov et al. ("Pintsov").

Claim Rejections Under 35 U.S.C. § 102(e)

The Applicants request review of the rejection of all claims for the reasons stated herein. The cited referenced does not teach all of the claim limitations, either expressly or inherently, as required for a proper rejection under 35 U.S.C. § 102(e).

Claim 1 recites "wherein the mail items in a tray are addressed to a common recipient." Claims 5, 13 and 18 include a similar element. Pintsov does not teach a plurality of mail items in a tray being addressed to a common recipient. Pintsov teaches processing bulk mail for a common mailer (column 2, lines 1-7), not a common recipient. The final Office Action states "Examiner maintains that the common recipient is the post office that receives the items from the mailer." This argument, however, fails to give patentable weight to the claim element. According to the claimed invention, the mail items are *addressed* to a common recipient. Pintsov does not teach that the mail items are all addressed to the post office, as is clearly evident from the mail item depicted in Fig. 1 addressed to "Mr. J HOMEOWNER." Hence, claims 1, 5, 13 and 18 are believed to be allowable, at least for this reason.

Claims 1 and 5 recite "a plurality of mail processing machines that are adapted to process the mail items through any of a plurality of distinct processing paths through the plurality of mail processing machines." Pintsov does not teach mail processing machines. In the response to arguments section, the final Office Action appears to assume that Pintsov teaches mail processing machines ("[t]hese operations require machines . . ."), even though Pintsov does not teach mail processing machines, much less mail processing machines that are "adapted to process the mail items through any of a plurality of distinct processing paths through the plurality of mail processing machines." The final Office Action goes on to misapply the doctrine of inherency to conclude that Pintsov teaches distinct processing paths through the mail processing machines. The Applicants traverse this misapplication of the doctrine of inherency

inasmuch as the element is not necessarily present in the reference as required for a proper application of the doctrine. It appears that Pintsov teaches a single processing path, and that processing path is not taught to be through mail processing machines. Hence, claims 1 and 5 are believed to be allowable for this additional reason.

Similarly, claim 13 recites “processing each of the plurality of process segments through different processes.” Pintsov does not teach processing through different process segments. Claim 13 is, therefore, believed to be allowable for this additional reason.

Claims 1, 5, 13 and 18 are believed to be allowable for the additional reason that Pintsov does not teach that “each tray tag includes recipient information identifying processing requirements relating to the recipient of the mail items in the tray associated with the tray tag.” The final Office Action failed to address this argument. Moreover, in light of other arguments made by the final Office Action that the recipient is the post office, each tray tag would be required to include processing requirements for the post office. This is not taught by Pintsov, and claims 1, 5, 13 and 18 are believed to be allowable for this additional reason.

The remaining claims depend from one of these independent claims and are believed to be allowable, at least for the reasons stated above. Claim 15 is believed to be allowable for the additional reason that Pintsov does not teach that each mail item includes a remittance to the recipient which, according to the reasoning of the final Office Action, would have to be the post office. Claim 16 recites “wherein the mail is processed by a processor for the recipient according to particular processing standards, and wherein the processor receives compensation from the recipient based on the processor’s performance with respect to the standard, and wherein the tray tags include information that identifies the processing standards for the recipient relating to the tray.” These limitations are not taught by Pintsov. The final Office Action has not addressed the Applicants’ arguments pointing out the shortcomings of the cited reference. Simply saying that “Pintsov does disclose . . . a processor receiving compensation” fails to give patentable weight to the claim elements. Moreover importantly, however, Pintsov does not teach a processor receiving compensation from a recipient, which

recipient would have to be the post office, according to the arguments presented in the final Office Action.

Conclusion

In view of the foregoing, Applicants respectfully request withdrawal of the rejections and issuance of a formal Notice of Allowance.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: February 1, 2007

/Irvin E. Branch/

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